



UNITED STATES DEPARTMENT OF COMMERCE  
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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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07/542,149 06/22/90 KEITH

EXAMINER

BUGAISKY, G

18M2/0611

FOLEY & LARDNER  
SUITE 500

3000 K ST. N.W.

WASHINGTON, D.C. 20007-5109

ART UNIT

PAPER NUMBER

1814

DATE MAILED:

06/11/93

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 3/31/93 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- |   |  |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.        | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948.                   |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.             | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____  |

Part II SUMMARY OF ACTION

1. ☒ Claims 11-22 are pending in the application.

Of the above, claims 17-22 are withdrawn from consideration.

2. ☐ Claims \_\_\_\_\_ have been cancelled.
3. ☐ Claims \_\_\_\_\_ are allowed.
4. ☒ Claims 11-16 are rejected.
5. ☐ Claims \_\_\_\_\_ are objected to.
6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable, ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_ has (have) been ☐ approved by the examiner, ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on \_\_\_\_\_, has been ☐ approved, ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received, ☐ not been received  
☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

The declaration filed 3/31/93 is deemed insufficient to change the inventorship. The requested change from one single inventor to another single inventor is an extremely serious matter, and all possible issues regarding the changed

5 inventorship must be addressed. It is noted that in section 6 of the original declaration under 37 C.F.R. 1.131 by Dr. Keith, it is stated that the work was carried out under his supervision, and that in Dr. Cieplak's declaration it is stated that the copies are from his own notebook and that he was the one who  
10 carried out the work recorded on the submitted notebook pages. The handwriting on those pages does not appear to be the same throughout. It is requested that the following be submitted: a) who performed (not supervised) each submitted experiment, b) a copy of the front page of the notebook verifying Dr. Cieplak as  
15 owner, a copy of the table of contents (page numbers and dates may be withheld), c) corroboration of Dr. Cieplak's declaration by Dr. Keith, and d) sufficient explanation why supervision by Dr. Keith does not contribute to inventorship (supervision by a laboratory head generally precludes technicians from claiming  
20 inventorship), i.e., why, instead of adding Dr. Cieplak as a joint inventor, which would appear to be the most logical step if the work was carried out under Dr. Keith's supervision, is the inventorship being changed to preclude Dr. Keith's contribution? These matters have not been sufficiently addressed.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

5       A person shall be entitled to a patent unless --  
      (f) he did not himself invent the subject matter sought to be patented.

10       Claims 11-16 are rejected under 35 U.S.C. § 102(f) because the applicant did not invent the claimed subject matter. This rejection is made based on the unresolved issue of the requested change in inventorship, and will be withdrawn upon submission of an adequate explanation of the facts.

      Declaration of an interference is premature prior to resolution of all issues raised during prosecution.

15       This application contains claims 17-22 drawn to an invention non-elected with traverse in Paper No. 4. A complete response to the final rejection must include cancellation of non-elected claims or other appropriate action (37 C.F.R. § 1.144) M.P.E.P. § 821.01.

      No claims are allowed.

20       **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory

period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

5 A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED  
10 STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

15 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabriele E. Bugaisky, Ph.D. whose telephone number is (703) 308-4201.

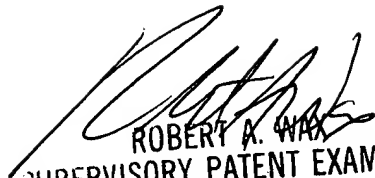
Papers related to this application may be submitted to Group 180 by facsimile transmission. Papers should be faxed to Group  
20 180 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM-1 Fax Center number is (703) 308-4227.

Any inquiry of a general nature or relating to the status of  
25 this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Serial No. 07/542,149  
Art Unit 1814

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geb  
June 10, 1993

  
ROBERT A. WAX  
SUPERVISORY PATENT EXAMINER  
GROUP 180